UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,143	12/13/2001	Herbert Peiffer	00/172 MFE	2770

7590 04/27/2004

ProPat, L.L.C.
2912 Crosby Road
Charlotte, NC 28211-2815

EXAMINER	
CHEN, VIVIAN	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,143	PEIFFER ET AL.	
	Examiner	Art Unit	
	Vivian Chen	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003 and 30 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 9, 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL) for the reasons set forth in the previous Office Action. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,423,401 (PEIFFER ET AL) claims a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, and process of making (patent claims 1-7,10) as recited in the application claims 1-7, 9. However, the patent does not explicitly claim the recited haze or gloss values.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional finishing methods and/or additives to modify the clarity

and the surface texture of the film in order to obtain the specific gloss (or lack thereof) and light transmittance properties desired for a given usage. It is well known in the art to use polyester films in packaging applications.

3. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of FUNDERBURK ET AL (US 4,493,872) or PEIFFER ET AL (US 6,214,440) for the reasons set forth in the previous Office Action.

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

FUNDERBURK ET AL discloses that it is well known in the art to apply a sulfonated copolyester coating derived from 65-96 mol% isophthalic acid, 0-30 mol% of the recited aliphatic dicarboxylic acid, 5-15 mol% of the recited sulfomonomer, and stoichometric amounts of the recited glycols in order to improve the adhesive properties of polyester films. PEIFFER ET AL '440 discloses that it is well known in the art to apply a sulfonated copolyester surface layer having the composition recited in claim 8 to a polyester film in order to improve the adhesive properties of the polyester film.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the adhesion promoting copolyester of FUNDERBURK ET AL or PEIFFER ET AL '440 in the surface layer of the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesion properties of the film.

4. Claims 10-12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of HIBIYA ET AL (US 6,136,420) for the reasons set forth in the previous Office Action.

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

HIBIYA ET AL discloses that it is well known in the art to heat-set polyester films at the conditions recited in claim 10 (lines 49-63, col. 16) in order to improve dimensional stability and to subject the film to conventional adhesion promoting treatments such as corona discharge prior to coating in order to enhance interlayer adhesion (lines 22-59, col. 14). The reference also discloses that it is well known in the art to incorporate scrap material into the film in typical amounts of 5-60 wt% in order to reduce material costs and waste generation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional heat-setting and adhesion promoting treatments as disclosed in HIBIYA ET AL on the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesiveness and the stability of the film. It also would have been obvious to recycle scrap film material for economic and environmental reasons. One of ordinary skill in the art would have adjusted the adhesion promoting treatment to optimize the surface tension for a specific coating material as indicated in claim 11.

5. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application 10/182,294 (PEIFFER ET AL) or 10/182,317 (PEIFFER ET AL) (now U.S. Patent No. 6,709,731);

in view of PEIFFER ET AL (US 5,955,181) for the reasons set forth in the previous Office Action.

The above copending Applications each claim a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, and process of making. However, the patent does not explicitly claim the recited haze, gloss, film orientation methods or use of regrind.

PEIFFER ET AL '181 discloses conventional orientation conditions for polyester films and antiblocking agents (lines 55-68, col. 6; column 8) typically used to obtain improved mechanical and surface properties of the film in addition to the use of regrind in order to reduce waste material.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional finishing methods and/or additives to optimize the clarity and the surface texture of the film in order to obtain the specific gloss (or lack thereof) and light transmittance properties desired for a given usage.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GERMAN PATENT APPLICATIONS 100 07 723 A1 or 100 07 725 A1 or 100 07 722 A1 (hereinafter DE '723 or DE '725 or DE '722, respectively) or WO 01/60900 A1 or WO 01/60610 or WO 01/60613 for the reasons set forth in the previous Office Action.

The above references each disclose a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, gloss, haze, and process of making as recited in the application claims 1-7, 9. (DE '722, entire document, specifically Table 1, claims, etc.) (see corresponding portions of the other references)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the surface properties of the prior art films in order to obtain the specific film handling and optical properties required by a given end use.

Response to Arguments

8. Applicant's arguments filed 11/24/2003 and 1/30/2004 have been fully considered but are not deemed persuasive for the following reasons:

(A) Applicant argues that PEIFFER ET AL '401 and '399 are disqualified as prior art under 35 USC 103(c). However, these references are not used as the basis of a rejection under 35 USC 103(a), based on 102(e), but rather as the basis of rejections under ***obviousness-type double patenting;*** therefore the publication (or issue) date is irrelevant and 35 USC 103(c) is ***NOT*** applicable as grounds for disqualification. In fact, common ownership is one of the essential criteria for double patenting rejections.

(B) Applicant argues that the references DE '723 and DE '722 and DE '722 and WO '900 and WO '610 and WO '613 were not received by Applicant. Additional copies of DE '723 and DE '722 and DE '722 will be included in the present office Action. In regard to WO '900 and WO '610 and WO '613, the Examiner wishes to point out that these references were provided in ***Applicant's own IDS*** (filed 5/29/2002).

(C) Applicant argues that DE '723 and DE '722 and DE '722 and WO '900 and WO '610 and WO '613 cannot be used against the present application because the application has a priority date of 12/20/2000, which is earlier than the publication date of 8/23/2001 for the above references. However, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

(D) Applicant further argues that DE '723 and DE '722 and DE '722 and WO '900 and WO '610 and WO '613 are disqualified under 103(a) because they are commonly owned by with the present Application. However, the above applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 (specifically, 35 U.S.C 102(a)) -- Applicant has not provided a certified translation of the foreign priority documents and therefore is presently only entitled to the US filing date of 12/13/2001 (see section (C) above) -- and accordingly the DE and WO references is not disqualified as prior art under 35 U.S.C. 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another", or by antedating the applied art under 37 CFR 1.131.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 15, 2004

Vivian Chen
Primary Examiner
Art Unit 1773